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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,641	04/08/2004	William H. Hohenstein	4015.3002 US	8471
38473	7590	10/31/2005	EXAMINER	
ELMORE PATENT LAW GROUP, PC 209 MAIN STREET N. CHELMSFORD, MA 01863			PHAN, THANH S	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,641	<b>Applicant(s)</b> HOHENSTEIN ET AL.	
	<b>Examiner</b> Thanh S. Phan	<b>Art Unit</b> 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 19-23 is/are rejected.
- 7) ☒ Claim(s) 11-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/17/05</u> | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willens [US 2,444,392] in view of CH666979.

Regarding claims 1, 3, Willens discloses a watchcase [fig. 5] comprising: a lower case [11] characterized by a first annular recess [not explicitly labeled; recess wherein 12 is fitted into 11] for receiving an optically cylinder [12] and a timepiece support [19] for receiving a timepiece mechanism [motor 17 and its associate component for the indication of time]; an upper case [13] characterized by on the bottom surface thereof, a second upper annular recess [groove 32] for receiving an optically cylinder; on the upper surface thereof, a track [portion wherein 27 is engaged with 14] for removably receiving and securing an ornament top [14]; an optically cylinder placed in said first and second annular recesses and between the lower and upper cases wherein the lower case, upper case and optically cylinder are fixedly connected.

Willens disclose the claimed invention except for wherein the cylinders are optical transparent.

CH666979 disclose a time telling device comprising a transparent cylinder/dome [26] fitted over a base.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a transparent material as suggested by CH666979 with the cylinder of Willens for the purpose of viewable beyond the surface of the cylinder.

Regarding claim 2, Willens and CH 666979 disclose the claimed invention except for wherein the optical transparent cylinder is a sapphire cylinder.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use sapphire as the material of the cylinder for the purpose of facilitating a highly decorative and expensive time-telling device. Furthermore, sapphire, diamond or other precious stones/material are known for their relatively high hardness and resistance to wear.

Regarding claim 4, Willens disclose wherein the cylinder having time increments placed thereon [column 2, line 5 +] except for wherein the increments are viewed through the optically transparent cylinder.

CH666979 disclose wherein the time increments are view through the optically transparent cylinder/dome [abstract].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the teaching of CH666979 with Willens for the purpose of protecting the viewable time increments.

Regarding claim 5, Willens discloses wherein the lower case, upper case and optically cylinder are fixed connected with at least one screw/shaft [figure 5,

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the components are held together at the centrally engaged shaft 27; column 2, lines 27-33].

Regarding claim 10, Willens discloses wherein the track in the upper case is annular and disposed on a plane below the second annular recess [figure 5].

Regarding claim 19, Willens and CH666979 disclose the claimed invention except for wherein a removable wristband is attached.

It would have been obvious to one of ordinary skill in the art to modify the time indicating device of Willens, as modified, to include a wristband to facilitate a securing device for a dynamic user.

Regarding claim 20, Willens, as modified, would produce a visually expose timepiece mechanism except for wherein the outer surface of the lower case is optical transparent. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Willens, as modified, by constructing the lower casing of a transparent material which serve as a protective layer to a visually expose component, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. In re Leshin, 125 USPQ 416 (CCPA 1960).

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willens and CH666979 as applied to claim 5 above, and further in view of Harrison [US 2,036,046].

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Regarding claims 6, 7 and 9 Willens and CH666979 disclose the claimed invention except for wherein the components are fixed together with a plurality of screws arranged annularly.

Harrison discloses a time indicating device [figure 2] wherein the upper and lower cases [1, 31, 17] are fixed together with a plurality of screws [32, 18] within/internally of the cases.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the mounting screws of Harrison with Willens, as modified, to securely engaging the cases together.

Regarding claim 8, Willens, as modified, disclose the claimed invention except for wherein the screws are arranged internally instead of externally of the cases.

However, it would have been obvious to modify Willens, as modified, by having the screws along the external of the cases since applicants have presented no explanation that this particular location of the screws is significant or is anything more than one of numerous locations a person of ordinary skill in the art would find obvious for the purpose of securing the cases together. A shifting in location is generally recognizing as being within the level of ordinary skill in the art when the operation of the device would not thereby be modified. In re Japikse, 86 USPQ 70 (CCPA 19500).

***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisk [US 2,513,465].

Regarding claim 21, Fisk discloses a ornament top [18] adapted to be worn on a watchcase [10] wherein said ornament top comprises (a) an upper surface [not explicitly numbered] adorned with an ornament [sphere structure at the top]; (b) a flange [not explicitly numbered; figure 2] on the bottom surface, extending inwardly with respect to said watchcase from the upper of the watchcase; and (c) at least one bayonette extending further outwardly from said flange configured to removably engage in a track in said watchcase [see figure 2].

Regarding claim 22, Fisk discloses wherein said ornament comprises a sculpture [sphere].

Regarding claim 23, Fish discloses wherein the sculpture has a height of at least **about** 1 cm [figures 1].

#### ***Allowable Subject Matter***

Claims 11-18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

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***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hohenstein et al. [US 6,891,778] ; Milles [US 4,817,064].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S. Phan whose telephone number is 571-272-2109. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tsp

  
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